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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,562	03/23/2004	David L. Marvit	073338.0190 (04-50462 FLA	4041
5073	7590	12/31/2009	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			LIANG, REGINA	
			ART UNIT	PAPER NUMBER
			2629	
			NOTIFICATION DATE	DELIVERY MODE
			12/31/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/807,562

Applicant(s)

MARVIT ET AL.

Examiner

Regina Liang

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/09 has been entered. Claims 1-21 are pending, claim 21 is withdrawn from consideration.
2. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Election/Restrictions

3. Newly submitted claim 21 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: see restriction below.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a device and a method for remotely controlling device comprising determining a matching gesture by comparing the tracked movement against the remote command gestures, classified in class 345, subclass 158.
- II. Claim 21, drawn to a handheld device generate the current image using the first , second accelerometers and tilt detection component, classified in class 345, subclass 157.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as determining a matching gesture by comparing the tracked movement against the remote command gestures without a tilt detection component comprising a camera, a video analysis module and a range finder as in invention II. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Current claims 1-20 are the same as the finally rejected claims and the rejections were upheld by the Board of Appeals, therefore the rejections stand and are repeated as follows.

Claim Rejections - 35 USC § 103

9. Claims 1-6, 8-12, 14-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al (US 5,598,187 hereinafter Ide) in view of Ishida (US 2004/0061621).

As to claims 1, 20, Figs. 1-3 of Ide discloses a handheld device (1) comprising: a motion detection module (motion detectors) operable to detect motion of the handheld device within three dimensions, a gesture database (motion pattern memory 42 in Fig. 15) maintaining a plurality of remote command gestures, each remote command gesture defined by a motion of the device with respect to a position of the handheld device (see Figs. 16, 17, and col. 14, lines 7-42); a gesture mapping database comprising a mapping of each of the remote command gestures to an associated command for controlling operation of the remote device (col. 14, lines 39-47); a control module (Fig. 15) operable to track movement of the handheld device using the motion detection module (motion detectors 30a, 30b), to compare the tracked movement against the

remote command gestures to determine a matching gesture, and to identify the one of the commands corresponding to the matching gesture; and a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device(col. 14, lines 7-47 for example).

Ide does not disclose the handheld device comprising a display having a viewable surface and operable to generate an image indicating a currently controlled remote device. However, Fig. 2 of Ishida teaches a remote control device including a display (monitor 17) having a viewable surface and operable to generate an image (lines 5-7 in [0025]). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of Ide to have a display as taught by Ishida such that a user can control the device while viewing the build-in monitor ([0013], [0041] of Ishida) and also “sets the operational feel of the rotating wheel to that corresponding to the notebook computer” ([0031] of Ishida; also see [0032, 0036, 0041]) such that the device can be easily controlled while viewing the built-in monitor (see Ishida [0041, 0043, 0046]).

As to claim 2, Fig. 7B of Ide teaches the remote receiver comprises a wireless interface of the remote device.

As to claim 3, Fig. 2 of Ishida teaches the remote receiver comprises an element of a public wireless telephone network (5).

As to claims 4, 5, Ide teaches the identified command of the remote receiver comprises audio/visual equipment (col. 14, lines 14-21).

As to claim 6, Ide teaches the wireless interface is operable to transmit the matching gesture to the remote receiver for delivery to the remote device (see Fig. 15).

Claims 8-12, 14-18, which are method claims corresponding to the above apparatus claims 1-5, are rejected for the same reasons as stated above since such method "steps" are clearly read on by the corresponding "means".

10. Claims 7, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide and Ishida as applied to claim 1 above, and further in view of Lapidot (WO 01/86920).

Ide as modified by Ishida does not explicitly disclose using first, second and third accelerometers for sensing the motion of the device along a first, second and third axis. However, Fig. 6 of Lapidot teaches using three accelerometers (601-A to 601-C) for sensing the motion of the handheld device along a first, second and third axis. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of Ide as modified by Ishida employ first, second and third accelerometers for sensing the motion of the handheld device along a first, second and third axis as taught by Lapidot since the three accelerometers measure the acceleration of the device along three independent directions precisely.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 2629

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Regina Liang/
Primary Examiner, Art Unit 2629